

REMARKS

Claims 1-5, 8-10, 13, 15-19, 22, 23, 27-31, 34, 35, and 37-64 are pending in the present application. By this amendment, all previously submitted claims have been canceled. New claims 65-102 are added by the amendment for the Examiner's reconsideration.

Claim Renumbering

In the aforementioned Office Action, the Examiner pointed out a duplication of claim numbering for claim 40, and requested renumbering of the claims starting from claim 41.

Applicants appreciate the keen observation by the Examiner. By this amendment, claims that need to be renumbered have been canceled, thereby obviating the need for any renumbering of such claims.

Claim Rejection under 35 USC § 102

In the aforementioned Office Action, claim 39 was rejected under 35 U.S.C. § 102(e) as being anticipated by *Siddiqui et al.* (U.S. Patent No. 6,826,176).

Claim 39 has been canceled in this amendment and the Examiner's rejection is thereby obviated.

Claim Rejection under 35 USC § 103

Claims 1, 38 and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hsu et al.* (U.S. Publication No. 2003/0054807) in view of *Siddiqui et al.* In the rejection, the Examiner basically alleged *Hsu et al.* discloses all features as claimed by applicants but conceded that *Hsu et al.* does not teach an IP multicast address and UDP port number be included in the BCMCS_ID. Nevertheless, since *Siddiqui et al.* mentions features relating to an IP multicast address and UDP port, the Examiner alleged that a person of ordinary skill in the art would have combined *Hsu et al.* and *Siddiqui et al.* to arrive at applicants' claim.

First, claim 64 has been canceled and the Examiner's rejection is thereby rendered moot. New claims 65 and 102, which essentially include all the limitations of canceled claims 1 and 38, respectively, are submitted to be patentable over the prior art.

There is no need to include the highlighted features as identified by the Examiner in *Siddiqui et al.* to distinguish over the prior art. As such, the relevant limitations have been deleted in new claim 65, which basically is a reinstatement of claim 1 as originally filed. New claim 65 now recites, *inter alia*, of "using the service ID in the broadcast service parameters message at the mobile station to determine availability of the broadcast service in an adjacent sector." Nowhere in the cited references is there any mention of relying on any service ID of the existent sector to determine the availability of the broadcast service of the adjacent sector.

First, the aforementioned claim limitation is fully support in the specification. Exemplary embodiments are disclosed, for example, from paragraph [1062] to paragraph [1091] of applicants' disclosure in describing Figs. 7-20.

In the rejection, the Examiner pointed out paragraphs [0083], [0089], and [0093] of *Hsu et al.* as meeting the limitation of "using the service ID in the broadcast service parameters message at the mobile station to determine availability of the broadcast service in an adjacent sector" of applicants' original claim 1, which is now canceled.

Applicants respectfully disagree.

Detailed study of *Hsu et al.* would reveal that *Hsu et al.* does not rely on any service ID of currently engaged sector to determine the availability of the broadcast service of any adjacent sector. Quite the contrary, as stated in paragraph [0089], second sentence, of *Hsu et al.*, "[w]hen the monitored sectors (*sic*, i.e., the serving sector, please see the sentence immediately before) no longer the best sector, the mobile station switches out of the serving sector into a new sector. After switching of the cells, the mobile station monitors the same BCMCS but uses a different set of the three values signaled for the new sector."

Phrased differently, *Hsu et al.* makes the sector switch from the current sector to the adjacent sector irrespective of any availability of any adjacent sector. In *Hsu et al.*, uninterrupted data reception from one sector to the other sector is possible if the adjacent sectors are assumed to be available for handoff, as can be inferred from lines 10-13 of paragraph [0089] of *Hsu et al.*,

under the assumption that if each base station is “[u]sing the public, mac_id value, multiple stations are able to receive the same BCMCS data frame communicated upon the F-PDCH.”

Without the aforementioned assumption, handoff may not be possible, as stated in the last sentence of paragraph [0093] of *Hsu et al.* which states that “BCMCS parameters of the new sector might not be available prior to the switching, causing an interruption of the data reception.”

In short, *Hsu et al.* does not have any particular teaching for proper handoff, much less the specific teaching of “using the service ID in the broadcast service parameters message at the mobile station to determine availability of the broadcast service in an adjacent sector,” as claimed by applicants.

With a claim limitation not found in the prior art, a *prima facie* case of obviousness cannot be established. MPEP § 2143.03. In light of the aforementioned features lacking in *Hsu et al.* and *Siddiqui et al.*, the rejection of claim 65 based on 35 U.S.C. § 103(a) cannot be sustained and should be withdrawn.

The same holds true for new claim 102, which in essence includes all the limitations of canceled claim 38. That is, there is no “means for using the service ID in the broadcast service parameters message at the mobile station to determine availability of the broadcast service in an adjacent sector” found in *Hsu et al.* or *Siddiqui et al.*, singly or in combination, as explained above.

In the aforementioned Office Action, claims 1-3, 5, 15-17, 19, 27-29, 31, 37-44, 49-53, 56-60, 63 and 64 were also rejected under 35 U.S.C. § 103(a) as unpatentable over *Sato* (EP 1 185125 A1) in view of *Siddiqui et al.* Furthermore, claims 4, 8, 9, 10, 13, 18, 22, 23, 30, 34, 35 45-48 and 54-55 were also rejected under 35 U.S.C. § 103(a) as unpatentable over *Sato* in view of *Siddiqui et al.* and further in view of *Chang et al.* (U.S. Patent Pub. No. 2002/0202967).

As mentioned earlier, by this amendment, claims 1-64 have been canceled. The Examiner’s rejection on these claims is thereby averted.

New independent claims 65, 80, 92 and 102 basically include all the limitations of canceled independent claims 1, 16, 28 and 38, respectively, are submitted to be patentable over the cited references and are collectively discussed below.

To begin with, applicants respectfully submit that the reference of *Sato* is misconstrued and further inappropriately combined with *Siddiqui et al.* and *Chang et al.*

In the rejection, based on *Sato*, the Examiner contended that the claimed features are mostly found in applicants' claims. For example, comparing to claim 65 which corresponds to canceled claim 1, the Examiner stated that in paragraph [0185] and paragraph [0186], *Sato* teaches the limitations of "providing a BCMCS_ID to identify the broadcast service," "sending the BCMCS_ID to a base station," and "configuring a broadcast service parameter message at the base station that includes the BCMCS_ID."

However, detailed study of paragraphs [0185] and [0186] of *Sato* would reveal that the paragraphs disclose the compilation of a management table which is sent to the mobile station upon request for information update. Nowhere in *Sato* is there any mention of "providing a service ID" and "sending a service ID" as claimed in new claim 65 by applicants, much less "configuring a broadcast service parameters message at the base station that includes the service ID." "Service ID" and "broadcast service parameter message" as claimed by applicants are brief in nature and thereby do not consume precious bandwidth. As such, they can be sent in an overhead channel or multiplexed with a payload channel for transmission, while, among other things, minimizing any interference of the main data traffic. This has been explained, for example, in paragraphs [1058] and [1068] of applicants' disclosure and is repeated herein for the Examiner's reference.

In sharp contrast, relevant administrative information in *Sato* is carried in the management table. The transmission of the management table is interleaved with the main traffic (see Fig.11 and the related description in paragraphs [0085] to [0087] of *Sato*). As such, valuable bandwidth must be carved for such purpose, substantially interfering with the main data traffic. The management table of *Sato* is not and cannot be construed as a service ID. Nor is there any service ID included in the management table.

In patent examination, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of patentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then

without more, the applicant is entitled to a grant of the patent. *In re Oetiker*, 977 F.2d 1443, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992).

Here, for reasons as stated above, applicants respectfully submit that the Examiner has not established a *prima facie* case, even without further discussing whether *Siddiqui et al.* and *Chang et al.* are properly combined with *Sato*. Accordingly, the rejection should be withdrawn.

Independent new claims 92 and 102 are submitted to be patentable for the same reasons as new claim 65 is believed to be patentable. As for independent claim 80, it recites a base station in accordance with applicants' invention. Again, nowhere is there any mention of any "service ID that identifies" any "broadcast service" found in the cited references. Nor is there any teaching of "configuring a broadcast service parameters message that includes the second service ID" found in the prior art. Independent claims 65, 80, 92 and 102 are thus submitted to be patentable over the prior art.

New claims 66-79, 81-91, and 96-101, which basically include all the limitations of canceled claims 2-15, 17-27, and 32-37, respectively, are dependent claims dependent directly or indirectly on their respective independent claims 65, 80, and 92 and with additional limitations, are therefore submitted to be, *a fortiori*, patentable.

For the reasons stated above, withdrawal of the rejections under 35 U.S.C. § 103(a) is believed to be in order and is respectfully requested.

CONCLUSION

In light of the amendments and remarks, with claims 1-64 canceled, applicants respectfully submit that new claims 65-102 are distinguishably patentable over the prior art. The application is believed to be in condition for allowance. Reconsideration and an early allowance are respectfully requested.

Respectfully submitted,

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